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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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7055	7590	09/22/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C.			SAFAVI, MICHAEL	
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3673

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/814,066

Applicant(s)

KNAUSEDER, FRANZ

Examiner

M. Safavi

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 4-20 and 26-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 21-25 and 31-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### ***Interview Summary***

Applicant's characterization of the Examiner's comments during the interview of April 22, 2005 appears inaccurate. Examiner had not agreed "that the applied documents do not teach pre-applying the adhesive or the substance in, e.g., a factory setting." Rather, Examiner had indicated to Applicant's representative that recitation directed to the adhesive being applied off-site would not appear to add anything over the already recited language to "pre-applied" and appears directed to a method step defining a process under 35 USC 101. Thus, language directed to "pre-applied" would not be afforded patentable weight, (rather than "disregarded" as characterized by Applicant's response).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3, 21-25, and 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 in view of German reference 29703962 when considering any of Scarlett, Keller et al., and Turner.**

Austrian reference '560 discloses the configuration of attaching flat structural cladding or substrate components as recited in claims 1-20 of the instant application.

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Austrian '560 does not appear to disclose any specific use of adhesive with the attaching configuration. However, German reference 29703962 teaches utilization of a contact adhesive between tongue and groove joints so as to establish a secure engagement between cladding panels of a substrate. And, each of Scarlett, Keller et al., and Turner teach application of an adhesive upon or within a locking joint between structural members with Scarlett, for example, teaching a desire to establish a self-locking assembly to achieve a joint which does not require independent clamping or other retention means during curing of the glue or adhesive, col. 3, lines 45-48 of Scarlett. See, also, col. 2, lines 24-39 of Scarlett.

To have provided the floor tile assembly of Austrian '560 with adhesive between and within the tongue and groove joints between the panels 1, 2, including any particular adhesive, thus securely fastening adjacent floor tiles one to another while realizing any and all advantages of adhesives within a self-locking joint, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by German reference 29703962 when considering any of Scarlett, Keller et al., and Turner.

As concerns **claim 3**, the resulting panels would be "provided with a...coating [of adhesive] in the groove areas. Lines 5-7 of claim 3 appear directed to a process particularly, with apparent recitation of an element not utilized until the panels are connected together. Otherwise, any adhesive coating would moisten the tongue and/or groove area upon application thereto.

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As concerns **claim 25**, the resulting panels would have at least one of the lateral groove areas of the grooves provided with the adhesive and at least one of the sides of the tongue provided with the adhesive.

As concerns **claims 32, 33, and 35**, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided adhesive in any quantity including an amount that would not allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive.

**Claims 1-3, 21-25, and 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 in view of German reference 29703962 when considering any of Scarlett, Keller et al., and Turner as applied to claims 1, 2, 14-16, 21-24, and 31 above, and further in view of Roesch et al.**

Roesch et al., for example, teach utilization and advantages of various “two component” adhesives including microencapsulatable solvent adhesives that contain polymer resin and appropriate solvents as well as polyvinyl acetate base, methyl acrylate base, epoxide base etc. with such adhesives falling into a category of “latent adhesive material that becomes active after appropriate activation” along with “an activator which induces adhesion”. Roesch et al. teaches application to either one or both members being connected, col. 10, line 9. Roesch et al. further teaches application to either one or both members “prior to connection” at “another site”, (i.e., teaches “a

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pre-applied adhesive layer” as well as “applied off site”), col. 10, lines 36-40 and col. 5, lines 54-58.

To have provided the modified floor tile assembly of Austrian '560 with a two component adhesive, (including adhesive with activating substance, microencapsulated adhesive, etc.), between and within the tongue and groove joints between the panels 1, 2, thus securely fastening adjacent floor tiles one to another while realizing any and all advantages of such well known adhesives and particularly “two component adhesives”, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by Roesch et al. The recitations to “a pre-applied adhesive layer” as well as “applied off site” have not been afforded patentable weight as being directed to process in a claim to article of manufacture. However, Roesch et al. obviously teaches application of the adhesive “prior to connection” at “another site”, (i.e., teaches “a pre-applied adhesive layer” as well as “applied off site”).

As concerns **claim 3**, the resulting panels would be “provided with a...coating [of adhesive] in the groove areas. Lines 5-7 of claim 3 appear directed to a process particularly, with apparent recitation of an element not utilized until the panels are connected together. Otherwise, any adhesive coating would moisten the tongue and/or groove area upon application thereto. However, the adhesive taught by Roesch et al. would read upon “latent adhesive material that becomes active after appropriate activation” as well as “coating...is applied to the panels and moistens them shortly before they are joined together and comprises an activator which induces adhesion”.

As concerns **claim 25**, the resulting panels would have at least one of the lateral groove areas of the grooves provided with the adhesive and at least one of the sides of the tongue provided with the adhesive.

As concerns **claims 32, 33, and 35**, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided adhesive in any quantity including an amount that would not allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive.

As concerns **claim 36**, the resulting panels would have at least one component of a two-component glue along a first, (or tongue), edge and at least another component of the two-component glue along a second, (or groove), edge.

**Claims 32, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 in view of German reference 29703962 when considering any of Scarlett, Keller et al. as applied to claims 1-3, 21-25, and 31-35 above, and further in view of any of Robins et al. '902, Sjostedt et al. '715, Parasin '816, and Ryther '892.**

Though the limitation presented within each of claims 32, 33, and 35 appear as a presumed or desired effect which one of ordinary skill in the art would have obviously desired, each of Robins et al., Sjostedt et al., Parasin, and Ryther recognize the undesirability of excess adhesive seepage and therefore teach to abate as much as possible any undesirable effects of any possible excess adhesive seepage, col. 4, lines

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11-13 of Robins et al.; col. 9, line 65 to col. 10, line 10 of Sjostedt et al.; col. 3, lines 18-20 and claim 4 of Parasin; and col. 1, lines 63-67, col. 2, lines 32-36, col. 3, lines 18-20, and col. 4, lines 33-35 of Ryther. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided adhesive in any quantity including an amount that would not allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive as taught by any of Sjostedt et al., Parasin, and Ryther.

**Claims 32, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 in view of German reference 29703962 when considering any of Scarlett, Keller et al., and Turner, and Turner, and further in view of Roesch et al. as applied to claims 1-3, 21-25, and 31-36 above, and further in view of any of Robins et al. '902, Sjostedt et al. '715, Parasin '816, and Ryther '892.**

Though the limitation presented within each of claims 32, 33, and 35 appear as a presumed or desired effect which one of ordinary skill in the art would have obviously desired, each of Robins et al., Sjostedt et al., Parasin, and Ryther recognize the undesirability of excess adhesive seepage and therefore teach to abate as much as possible any undesirable effects of any possible excess adhesive seepage, col. 4, lines 11-13 of Robins et al.; col. 9, line 65 to col. 10, line 10 of Sjostedt et al.; col. 3, lines 18-20 and claim 4 of Parasin; and col. 1, lines 63-67, col. 2, lines 32-36, col. 3, lines 18-20,



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and col. 4, lines 33-35 of Ryther. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided adhesive in any quantity including an amount that would not allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive as taught by any of Sjostedt et al., Parasin, and Ryther.

### ***Response to Arguments***

Applicant's arguments filed June 24, 2005 have been fully considered but they are not persuasive. Applicant's remarks from the bottom of page 11 to the top of page 12 of the response, with respect to "label having an adhesive...", do not appear commensurate with the scope of the invention. Otherwise, it is not clear as to what applicant is asserting by "...such a recitation is a structural feature because it forms a tangible part of the claimed invention."

Applicant's arguments with respect to "preapplied adhesive layer" or "is applied off-site" appear directed to process when the rejected claims define an article of manufacture. The panel assembly of Australian '560, as modified, serves to read upon the article defined by the respectively rejected claims. The panel assembly of Australian '560, as modified in the above proposed rejections, can be formed as by pre-applying any adhesive and thus serve to read upon the language of the rejected claims with the term "preapplied" merely defining a process of manufacture. The product of Australian '560, as modified, and, the final product of the instant invention, (i.e., structural

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components with a glued interlocking tongue and groove joint), appear as one and the same. Otherwise, the patentability of a claim to a product does not depend on merely a difference in its method of production, but on whether the product itself is new and unobvious. In re Pilkington, 411 F.2d 348, 192 U.S.P.Q. 145, 147 (CCPA 1969). If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the product was made by a different process. In re Fessman, 489 F.2d 742, 180 U.S.P.Q. 324 (CCPA 1974) and In re Thorpe, 777 F.2d 695, 227 U.S.P.Q. 964 (Fed. Cir. 1985). When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. In re Brown, 450 F.2d 531, 173 U.S.P.Q. 685 (CCPA This burden is NOT discharged solely because the product was derived from a process not known in the prior art. In re Fessman, supra.

Applicant's remarks with regard to "...eliminated is the unpleasant welling out of excess glue, which must be removed immediately after having left the joints, so as to avoid the formation of spots on the decorative layer" appear as a presumed or desired effect. At any rate, and as evidenced by any of Robins et al., Sjostedt et al., Parasin, and Ryther, one of ordinary skill in the art would have found it obvious to apply the adhesive in a manner and fashion that would serve to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive. It is, otherwise, not seen how "in using the glue of Scarlett in the application of the Australian reference, an

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excessive quantity of glue may result...". Each of Scarlett, Keller et al., and Turner are utilized to teach gluing an interlocking tongue and groove joint. Applicant has failed to establish how the claimed product differs in kind from that of the modified Australian '560 assembly.

In response to applicant's argument that "the applied prior art documents [do not] recognize the problem which is solved by the instant claimed invention", the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant's argument that the Roesch et al. adhesives "are not necessarily the same types of adhesives that would be used in configurations according to claims 1 and 31", appear as assumption. And, Applicant's statement that, "ROESCH does not disclose or suggest a pre-applied adhesive layer or a pre-applied layer of a substance that activates an adhesive in the type of structures recited in independent claims 1 and 31, much less, ones which are applied off-site" appears incorrect.

With regard to "ROESCH does not disclose or suggest...[an] adhesive layer or a...layer of a substance that activates an adhesive in the type of structures recited in independent claims 1 and 31", one having ordinary skill in the art would certainly turn to the Roesch et al. teaching of an adhesive attachment of pipes, fittings, and connectors when determining what specific adhesives could be used in the assembly of inter-fitting structural elements.

Applicant's remarks within the third paragraph on page 15 of the response have been noted. It is not clear as to how "Applicant...[would be] faced with the undue burden of responding to cumulative rejections that add nothing of substance or specificity to the prosecutorial record." The rejection involving Roesch et al. may appear more specific to claims 3 and 25 however, the rejection involving Roesch et al. may also address limitation(s) at lines 13-14 in claim 1, lines 8-9 in claim 31, and lines 11-12 in claim 34. Limitations within each of claims 3 and 25 may or may not present a two component adhesive.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (571) 272-7046. The examiner can normally be reached on Mon.-Thur., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (571) 272-7049. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**MICHAEL SAFAVI**  
**PRIMARY EXAMINER**  
**ART UNIT 354**

M. Safavi  
September 10, 2005